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In re Application of
KISHIMOTO, Tadimitsu *et al*
U.S. Application No.: 09/646,785
PCT No.: PCT/JP99/01448
Int. Filing Date: 23 March 1999
Priority Date: 24 March 1998
Attorney Docket No.: 046124-5042
For: VASCULARIZATION INHIBITORS

DECISION

UNDER

37 CFR 1.181

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.181 and M.P.E.P. § 710.06 to Reset the Period for Reply to a Notification of Missing Requirements Under 35 U.S.C. § 371 Due to Late Receipt of the Notifications" ("Pet.") filed 16 February 2001. No fee is required.

BACKGROUND

On 23 March 1999, applicants filed international application PCT/JP99/01448 claiming priority to a Japanese patent application filed 24 March 1998. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 30 September 1999.

On 23 March 1999, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 25 September 2000 (24 September 2000 was a Sunday).

On 22 September 2000, applicants filed for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, an English translation, a preliminary amendment, a check of \$1,356.00 for the required fees, and authorization to charge any additional fees to Deposit Account No. 50-0310.

On 24 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. A one month time limit in which to respond was set.

On 16 February 2001, applicants submitted the instant petition which was accompanied by, *inter alia*, an executed declaration; the \$130.00 surcharge fee; a printout labeled "Actions Due"; a printout labeled "Country Application"; and a printout purportedly showing other Notification of Missing Requirements received by the law firm on 24 October 2000.

DISCUSSION

Section 710.06 of the Manual of Patent Examining Procedures (MPEP) states that the PTO will grant a petition to restart the previously set period for reply to a PTO action when the following criteria are met:

(A) the petition is filed within 2 weeks of the date of receipt of the PTO action at the correspondence address;

(B) a substantial portion of the set reply period had elapsed on the date of receipt (e.g., at least 1 month of a 2- or 3-month reply period had elapsed); and

(C) the petition includes (1) evidence showing the date of receipt of the PTO action at the correspondence address (e.g., a copy of the PTO action having the date of receipt of the PTO action at the correspondence address stamped thereon, a copy of the envelope (which contained the PTO action) having the date of receipt of the PTO action at the correspondence address stamped thereon, etc.), and (2) a statement setting forth the date of receipt of the PTO action at the correspondence address and explaining how the evidence being presented establishes the date of receipt of the PTO action at the correspondence address.

Applicants claim that the Notification of Missing Requirements mailed 24 October 2000 was not received until 12 February 2001. The instant petition was filed 16 February 2001. Thus, item (A) is satisfied.

Item (B) is also satisfied since the one month period to reply to the Notification of Missing Requirements mailed 24 October 2000 had long expired on 12 February 2001.

Concerning item (C), applicants have submitted a "printout from our Firm's patent docketing system labeled "Actions Due." Pet. ¶ 4 (#2). Petitioners claim that this document shows that "the Notification was not entered into our docketing system until February 12, 2001 (the "Date Created")." *Id.* Then, petitioners declare that since "it is our longstanding Firm policy and practice to docket papers received from the PTO within one day of receipt, we submit this as evidence that the Notification did not arrive at our Firm until February 12, 2001." *Id.*

The exhibits accompanying the present petition establish only that the "Notification of Missing Requirements" was **docketed** on 12 February 2001, not that the communication was in fact **received** on that date. While the petition states that it is the firm's "policy and practice to docket papers received from the PTO within one day of receipt," petitioner has not provided evidence that such practice was in fact observed in the present case. As indicated above, evidence that would be useful in establishing the receipt date would include, e.g., a copy of the PTO action having the date of **receipt** of the PTO action at the correspondence address stamped thereon or a copy of the envelope having such date stamped thereon.

Therefore, applicants have not completed all of the requirements of section 710.06 of the MPEP to reset a period for reply due to late receipt of a PTO action.

CONCLUSION

For the reasons discussed above, applicants' petition to restart the time period to respond in the Notification of Missing Requirements has been **DISMISSED** without prejudice.

The declaration submitted is in compliance with 37 CFR 1.497(a) and (b). The surcharge fee of \$130.00 and three-month extension of time fee of \$890.00 has been charged to Deposit Account No. 50-0310 as authorized.

Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 23 March 1999, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **16 February 2001**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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